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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/024,482

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Daniella Giacchetti

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/024,482	<b>Applicant(s)</b> GIACCHETTI, DANIELLA	
	<b>Examiner</b> Igor Borissov	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claims 1 and 18 are objected to because of the following informalities: the phrase "wherein the displayed facial portion having a simulation corresponds to the at least one selected template" appears to be misspelled. Examiner understand this phrase as "wherein the displayed facial portion having a simulation, which corresponds to the at least one selected template".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent Claims 1, 16,17 and 18 recite a method, system or computer product for "*enabling a beauty analysis*". It is not clear what does the term "beauty" actually contemplates. Merriam-Webster's collegiate dictionary (10<sup>th</sup> ed.; page 101) provides following definitions (among others) of the term "beauty" 1): the quality or aggregate of qualities in a person or thing that gives pleasure to the senses or pleasurably exalts the mind or spirit; 2): a beautiful person or thing; 3): a particularly graceful, ornamental, or excellent quality; 4): a brilliant, extreme, or egregious example or instance. The body of each independent Claim does not provide any indication of which definition of the term "beauty" should be considered during prosecution of the Claims. What type of said qualities should be considered: ornamental or graceful? If said "beauty" relates to the way a person looks, than what criteria is used for defining said "beauty" state: condition of hair, amount of wrinkles on the face, dimensions or color of eyes? Reading the preamble, the examiner does not understand what actually supposed to be diagnosed. Furthermore, said definitions clearly indicate that the term

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"beauty" is not a technical term, but rather is subjective one. As such, the term "beauty" renders the Claim vague and indefinite.

Furthermore, as per Claims 1, 16, 17 and 18, the terms "enabling selection" and "facilitating display" are vague and indefinite. The Claims do not recite actual "selecting" and "displaying" steps. Therefore, the examiner does not understand how said "enabling selection" and "facilitating display" steps differ from "selecting" and "displaying" steps.

Furthermore, as per Claims 1 and 18, the preamble does not correspond to the body of the Claims. The preamble refers to a "beauty analysis", while the body of the Claims recite only steps of presenting information on the display, and do not provide any indication of any analysis whatsoever.

Same reasoning applied to the remaining Claims.

### ***Claim Rejections - 35 USC § 101***

#### **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-30 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

**(a) “Useful”** – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

**(b) “Tangible”** – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

**(c) “Concrete”** – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than presenting information to a consumer. The method step of: “*enabling* selection of at least one of the displayed templates” does not require the actual *selection* step to be

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performed. Same reasoning is applied to the step of: "facilitating display", which does not require the actual *displaying* step to be performed.

Accordingly, the claimed invention does not appear to provide tangible and/or useful result and is, therefore, deemed to be non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-11 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Orpaz et al. (US 6,937,755).**

Orpaz et al. (Orpaz) teaches a computer-implemented method, computer-readable medium and system for simulating an appearance of make-up and fashion accessories on an human image, said system including a processor and a wide area network, said method comprising:

#### **Independent Claims**

Claims 1, 16, 17 and 18. Facilitating of displaying a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product (Figs. 12-18; C. 6, L. 20-41);

enabling selection of at least one of the displayed templates (C. 6, L. 61-65);

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation corresponds to the at least one selected template (C. 6, L. 66 – C. 7, L. 13).

Dependent Claims

Claim 2. Said method, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion along with a simulation of a differing beauty product (C. 2, L. 63-66).

Claim 3. Said method, wherein the beauty product comprises make-up, and wherein each template in the group of templates has a simulation of a differing make-up (C. 2, L. 63-66).

Claim 4. Said method, wherein each template in the group has a simulation of make-up with at least one of a differing color, a differing texture, a differing brand, and a differing formulation (C. 3, L. 10-12, 47, 53-55; C. 4, L. 5-11).

Claim 5. Said method, wherein the plurality of templates comprise a group of templates each having a different shaped facial portion (Figs. 12-18).

Claim 6. Said method, wherein the facial portion is chosen from lips, eyes, cheeks, and eyebrows (Figs. 12-18).

Claim 7. Said method, wherein the beauty product comprises make-up (C. 1, L. 50-54; C. 5, L. 1-5).

Claim 8. Said method, wherein the simulated facial image is one of two-dimensional image and a three-dimensional image (Fig. 6).

Claim 9. Said method, wherein the simulated facial image is displayed on a simulated likeness of at least a portion of a human (C. 2, L. 63-66).

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Claim 10. Said method, further comprising enabling selection of at least one article of clothing, wherein the selected article of clothing is displayed on the simulated likeness (C. 10, L. 9-17).

Claim 11. Said method, wherein at least one of facilitating display of a plurality of templates, enabling selection of at least one of the displayed templates, and facilitating display of a simulated facial image comprises providing access to software (C. 6, L. 61-65; C. 3, L. 21-26).

Claim 13. Said method, comprising enabling application of coloration to the simulated facial image to simulate at least one of actual skin tone and actual hair color (C. 10, L. 47-49).

Claim 14. Said method, wherein the beauty product comprises a cosmetic product chosen from mascaras, eye shadows, eye liners, foundations, concealers, blushers, lip make-ups, lip sticks, lip glosses, and hair colorings (C. 10, L. 47-49).

Claim 15. Said method, wherein further comprising enabling storage of the simulated facial image for selective recall by an individual (C. 4, L. 29-50).

Claim 19. Said method, wherein the beauty product comprises make-up (C. 5, L. 1-5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orpaz et al. in view of Lambertsen (US 2002/0024528).

*Dependent Claim*

Claim 12. Orpaz teaches all the limitations of Claim 12, except specifically teaching selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows.

Lambertsen teaches a virtual makeover system and method, wherein users can apply beauty products to an image of a human, and wherein various portion of a facial image including a head, eyes, nose, lips, ears, and eye brows are provided with a default shape, said default shape can be changed (reshaped) by the user (Fig. 4; [0010]; [0011]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz to include selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows, as disclosed in Lambertsen, because it would advantageously allow users to create a new "look" not only for themselves, but for other user as well, thereby potentially increase revenue (Lambertsen; [0011]).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

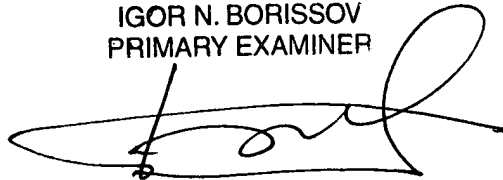
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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IGOR N. BORISSOV  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', is written over the printed name and title. The signature is stylized with a large loop at the end.